

REMARKS

Claims 36-74 and 81-84 are pending, with claims 36, 47, 68, and 81-84 being independent. Claims 36, 47, and 68 have been amended, claims 75-80 have been cancelled, and claims 81-84 have been added. In view of the following remarks, reconsideration and allowance of this application are respectfully requested.

Allowable Subject Matter

Applicants acknowledge the indication of allowable subject matter in previously pending claims 76, 78, and 80, the features of which have been incorporated into independent claims 36, 47, and 68, respectively. Other clarifying amendments also have been made to claims 36, 47, and 68, which are not believed to impact their allowability over the prior art. Accordingly, Applicants respectfully request allowance of claims 36-74.

35 U.S.C. § 102(e) Appelman Rejection

Claims 68 and 79 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Appelman (U.S. Patent No. 6,677,968). Claim 79 has been cancelled, rendering the rejection of claim 79 moot, and the features of claim 79 have been incorporated into independent claim 68, which is allowable for the reasons discussed above. The previously pending version of claim 68 has been recast as new claim 83, which is patentable over Appelman for at least the following reasons.

In Applicants' Amendment in Reply to Action of November 18, 2004, filed on February 17, 2005 ("February 2005 Reply"), Applicants addressed the rejection of previously pending independent claim 68 (now claim 83) as being anticipated by Appelman. The Office Action of June 3, 2005 ("June 2005 Office Action") is incomplete because it fails to address Applicants' remarks from the February 2005 Reply, which have also not been addressed in any other office action. M.P.E.P. § 707.07(f). Applicants therefore reiterate and incorporate by reference their remarks from the February 2005 Reply regarding independent claim 68, which are reproduced below for convenience:

Claim 68 is directed to a method of providing a buddy list to a network user, and recites, among other things, “receiving user definition of a first buddy list, the first buddy list comprising members defined by the network user,” “receiving user definition of a second buddy list, the second buddy list comprising members defined by the network user,” “triggering, based on the received user input, selection of a buddy list among the first buddy list and the second buddy list” and “displaying the selected buddy list to the network user on an instant messaging user interface.” Applicants respectfully submit that Appelman does not describe or suggest at least these features of claim 68.

In particular, as Applicants’ representative explained during the [February 3, 2005 Examiner] interview, Appelman does not describe or suggest at least receiving user definition of a first and a second “buddy list,” or triggering display of one of the “buddy lists” based on user input. As explained on page 3 of [Applicants’] September 7, 2004 Reply and as reiterated during the interview, the term “buddy list” in this application refers to an aggregated collection of online identifiers for whom online presence is reflected. This term is defined in Applicants’ specification as a list of “names of other server system users” and with reference to item 404 of Figure 4. (See Specification at page 3, lines 12-18). Notably, Figure 4 of this application makes clear that a buddy list includes one or more buddy groups, and that each buddy group can include one or more other buddies, necessarily distinguishing buddy lists, buddy groups, and buddies. This is consistent with the ordinary meaning ascribed to the term buddy list. To further clarify the meaning of the term buddy list, new dependent claims 79 and 80 recite that a “buddy list comprises one or more buddy groups defined by the network user” and that “members are grouped into the buddy groups by the network user,” respectively.

Appelman describes a system that tracks and displays, for a user, the logon status of co-users (i.e., buddies) on an online communications system, such as instant messaging. (Appelman at col. 2, lines 58-63). As discussed during the interview, it appears that the Examiner’s rejection relies upon Appelman’s disclosure of allowing a user to “define multiple buddy lists by group names.” (Appelman at col. 3, lines 48-49). However, as Applicants’ representative explained during the interview, Appelman ascribes a different definition to “buddy list” than the ordinary definition of buddy list used in this application. As shown in FIG. 2A, Appelman uses the term “buddy list” to refer to a list of buddies associated with a single buddy group, with all of the buddy groups stored in a Group Name table 30. (Id. at col. 3, lines 46-49). However, Appelman does not describe or suggest receiving user definition of, or selecting among, more than one “buddy list.”

where the term buddy list encompasses an aggregate collection of buddies, including any buddy groups and associated lists of buddy names.¹

For at least the reasons discussed above with respect to previously pending claim 68, Appelman fails to anticipate new independent claim 83. Accordingly, claim 83 is patentable over Appelman.

35 U.S.C. § 103(a) Schindler/Porter/Aravamudan Rejection

Claims 36-43, 47-60, 62-66, 69-72, 75, and 77 have been rejected under 35 U.S.C. § 103(a) as being obvious over Schindler (U.S. Patent No. 6,081,830) in view of Porter (U.S. Patent No. 6,434,599) and further in view of Aravamudan (U.S. Patent No. 6,301,609). Dependent claims 75 and 77 have been cancelled, rendering the rejections of claims 75 and 77 moot. The features of claims 75 and 77 have been incorporated into claims 36 and 47, respectively, which are allowable for the reasons discussed above. Dependent claims 37-43, 48-60, 62-66, 69-72 now depend from one of amended independent claims 36, 47, and 68, and are, therefore, allowable for the reasons discussed above.

Previously pending independent claims 36 and 47 have been recast as new independent claims 81 and 82 and are allowable over Schindler, Porter, and Aravamudan for at least the following reasons. In Applicants' Reply to Action of May 7, 2004, filed on September 7, 2004 ("September 2004 Reply"), Applicants addressed the rejection of independent claims 36 and 47 (now claims 81 and 82) as being as being obvious over Schindler in view of Porter and further in view of Aravamudan. The June 2005 Office Action is incomplete because it fails to address Applicants' remarks from the September 2004 Reply, which have also not been addressed in any other office action. M.P.E.P. § 707.07(f). Applicants therefore reiterate and incorporate by reference their remarks from the September 2004 Reply regarding independent claims 36 and 47. A copy of the September 2004 Reply is attached hereto for convenience. For at least the reasons

¹ The statement in the Examiner's Interview Summary that "Applicant argues that the group name table is equivalent to the buddy list they are speaking of" does not precisely capture the nature of the argument set forth by Applicants' representative. Rather, Applicants' representative asserted that the term "buddy list," as used in this application, refers to the aggregate collection of all buddy names and buddy groups, and could include, for example, all of the buddy group names and associated lists of buddies that are in a data structure like the Group Name table 30 in Appelman.

set forth in the September 2004 Reply, independent claims 81 and 82 are patentable over any combination of Schindler, Porter, and Aravamudan.

35 U.S.C. § 103(a) Schindler/Porter/Aravamudan/DeSimone Rejection

Claims 44-46, 53-55, 61, 67, and 73 have been rejected under 35 U.S.C. § 103(a) as being obvious over Schindler in view of Porter, further in view of Aravamudan, and further in view of DeSimone (U.S. Patent No. 6,212,548). Claims 44-46, 53-55, 61, 67, and 73 now depend from one of independent claims 36, 47, and 68, and are therefore allowable for at least the reasons discussed above.

Moreover, for at least the reasons forth in the September 2004 Reply, DiSimone does not remedy the deficiencies of Schindler, Porter, and Aravamudan. The June 2005 Office Action is incomplete because it fails to address Applicants' remarks from the September 2004 Reply, which have also not been addressed in any other office action. M.P.E.P. § 707.07(f). Applicants therefore reiterate and incorporate by reference their remarks from the September 2004 Reply regarding claims 44-46, 53-55, 61, 67, and 73.

For at least these reasons, claims 44-46, 53-55, 61, 67, and 73 are patentable over any combination of Schindler, Porter, Aravamudan, and DeSimone.

35 U.S.C. § 103(a) Aravamudan/Schindler Rejection

Claim 74 has been rejected under 35 U.S.C. § 103(a) as being obvious over Aravamudan in view of Schindler. Claim 74 now depends from amended independent claim 68, and is therefore allowable for at least the reasons discussed above.

In the September 2004 Reply, Applicants addressed the rejection of claim 74 as being as being obvious over Aravamudan in view of Schindler. The June 2005 Office Action is incomplete because it fails to address Applicants' remarks from the September 2004 Reply, which have also not been addressed in any other office action. M.P.E.P. § 707.07(f). Applicants therefore reiterate and incorporate by reference their remarks from the September 2004 Reply regarding claim 74.

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For at least these reasons, claim 74 is patentable over any combination of Aravamudan and Schindler.

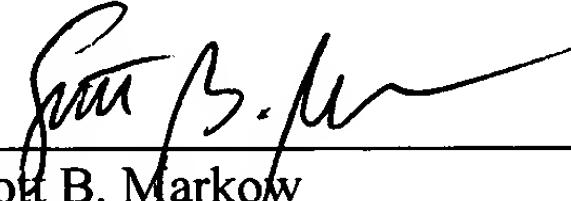
Conclusion

Applicants do not acquiesce to the characterizations of the art. For brevity and to advance prosecution, however, Applicants have not addressed all characterizations of the art, but reserve the right to do so in further prosecution of this or a subsequent application.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: Aug - 19, 2005



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Attorney's Docket No.: 06975-048001 / AOLTV 07

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Carlos Silva et al.
Serial No. : 09/475,391
Filed : December 30, 1999
Title : TELEVISION CHAT ROOMS

Art Unit : 2141
Examiner : April Baugh

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO ACTION OF MAY 7, 2004

Please reconsider the above-identified application in view of the following remarks.

REMARKS

Claims 36-74 are pending. Claims 1-35 have been cancelled. Claims 36, 47, and 68 are independent. In view of the following remarks, reconsideration and allowance of this application are respectfully requested.

35 U.S.C. § 102(e) Aravamudan Rejection

Claim 68 was rejected under 35 U.S.C. § 102(e) as being anticipated by Aravamudan (U.S. Patent No. 6,301,609). Applicants respectfully request withdrawal of this rejection.

Claim 68 is directed to a method of providing a buddy list to a network user, and recites, among other things, “receiving user definition of a first buddy list, the first buddy list comprising members defined by the network user,” “receiving user definition of a second buddy list, the second buddy list comprising members defined by the network user,” “triggering, based on the received user input, selection of a buddy list among the first buddy list and the second buddy list” and “displaying the selected buddy list to the network user on an instant messaging user interface.” Applicants respectfully submit that Aravamudan does not describe or suggest at least these features of claim 68.

Aravamudan describes a system in which a user “creates buddy groups.” (Aravamudan at col. 9, lines 50-51). The user then “defines specific attributes to associates (or buddies) included within each group.” (*Id.* at col. 9, lines 51-52). One attribute assigned by the user is each buddy’s priority level, defined as low, high, or highest. (*Id.* at col. 9, lines 59-61). The priority level determines how the buddy will be allowed to discern the presence of the user on the network. (*Id.* at col. 9, lines 64 to col. 10, line 56). For example, a buddy with high priority will be notified of the user’s real presence on the network, while a buddy with low priority will only be allowed to interact with the user’s proxy on the network. (*Id.*).

Through this disclosure, Aravamudan fails to describe or suggest at least two aspects of claim 68, namely: (1) “receiving user definition of a first buddy list” and “receiving user definition of a second buddy list,” and (2) “triggering, based on the received user input, selection of a buddy list among the first buddy list and the second buddy list” and “displaying the selected

buddy list to the network user on an instant messaging user interface.” Each is serially addressed below.

Receiving User Definition of First and Second Buddy Lists

The term “buddy list” refers to an aggregated collection of online identifiers for whom online presence is reflected. This term is defined in the Applicants’ specification as a list of “names of other server system users” and with reference to item 404 of Figure 4. Notably, Figure 4 makes clear the inclusion of buddy groups within and as a constituent parts of a buddy list, necessarily distinguishing buddy groups from buddy lists. This again is consistent with the ordinary meaning ascribed to the term buddy list.

Moreover, it is clear from the Applicants’ specification that the process of ascribing attributes to an online buddy or buddy group associates with a buddy list are processes that distinguish themselves from the process of receiving user definition of buddy lists. For example, the specification indicates that attributes may be ascribed to constituent buddies of a buddy list having buddy groups associated therewith. See page 3, lines 12-15.

In this context, Aravamudan fails to describe or suggest receiving user definition of a first buddy list and receiving user definition of a second buddy list, as claimed. Rather, Aravamudan describes the mere assignment of attributes (e.g., priority levels) to individual buddies within a buddy group. Aravamudan’s assignment of attributes to individual buddies in a buddy group may be similar to the assignment of attributes contemplated by the Applicants’ specification at page 3, lines 12-15, but it does not even relate to receiving user selection of multiple buddy lists, which is disclosed even within the Applicants’ specification as being distinct of the assignment of buddy attributes.

Moreover, the creation of buddy groups by Aravamudan also and similarly fails to meet receiving user definition of first and second buddy lists. Specifically, the buddy groups of Aravamudan are part of a buddy list and, therefore, fail to suggest creation (or receipt of user definition of) buddy lists to which they belong.

Triggering Selection of a Buddy List and Displaying the Selected Buddy List

Even overlooking the failure of Aravamudan to suggest receiving user definition of first and second buddy lists, it is clear that Aravamudan does not describe or suggest at least the claimed "triggering, based on the received user input, selection of a buddy list among the first buddy list and the second buddy list" and "displaying the selected buddy list to the network user on an instant messaging user interface." In fact, Aravamudan is silent as to whether the user can trigger among multiple buddy lists or display the selected buddy list on a user interface to the network user. Aravamudan simply is not concerned with the existence, management, or selection among multiple buddy lists.

For at least the foregoing reasons, independent claim 68 and its dependent claims 69-72 are patentable over Aravamudan.

35 U.S.C. § 103(a) Schindler/Porter/Aravamudan

Claims 36-43, 47-60, 62-66, and 69-72 were rejected under 35 U.S.C. § 103(a) as being obvious over Schindler (U.S. Patent No. 6,081,830) in view of Porter (U.S. Patent No. 6,434,599) and further in view of Aravamudan. Applicants respectfully request withdrawal of these rejections.

Independent claims 36 and 47 are directed, respectively, to a method of providing a buddy list to a network user and a computer program for providing a buddy list to a network user. Claims 36 and 47 each recite, among other things, "determining television programming selected for viewing by a network user," "accessing two or more user-defined lists of other users for whom presence is monitored," "selecting an initial buddy list from among the two or more user-defined lists based upon the determined television programming," and "displaying the selected initial buddy list to the network user on an instant messaging user interface." Each of the two or more user-defined lists includes members defined by the network user.

Schindler uses the identity of a television channel as a basis for identifying and automatically linking to a computer chat room. Stated differently, the point of Schindler is to

identify and link to chat rooms that correspond to the content presently tuned by a television.¹ Schindler does not, however, describe accessing two or more user-defined lists of other users for whom presence is monitored, nor does Schindler describe selecting an initial buddy list from among the two or more user-defined lists based upon the determined television programming.²

Porter does not remedy these deficiencies of Schindler. Porter describes dynamic formation of a chat session facilitated by an information site or a third party chat server. However, Porter fails to contemplate accessing two or more user-defined lists of other users for whom presence is monitored and selecting an initial buddy list from among the two or more user-defined lists based upon the determined television programming, as recited in claim 36.

Aravamudan also fails to remedy these deficiencies of Schindler and Porter. In particular, Aravamudan does not describe or suggest at least the claimed "accessing two or more user-defined lists of other users for whom presence is monitored," "selecting an initial buddy list from among the two or more user-defined lists," and "displaying the selected initial buddy list to the network user on an instant messaging user interface." As discussed above with respect to claim 68, Aravamudan is silent as to whether the user can trigger among multiple buddy lists or display the selected buddy list on a user interface to the network user. Aravamudan simply is not concerned with the existence, management, or selection among multiple buddy lists.

Rather, Aravamudan describes assigning attributes to individual buddies within a buddy group to determine how each of those buddies perceive the user. Therefore, Aravamudan fails to describe or suggest at least the claimed "selecting an initial buddy list from among the two or

¹ Fig. 3 of Schindler shows a computer, a display screen 38 that includes a TV program area 40, a chat room identification area 44, with a participant area 46 that lists names of users participating in the chat room, and a chat entry area 52 in which chat messages are displayed. The display screen 38 also includes a "TV controls area 42" with "on-screen buttons" that allow a user to change the channel of the TV programming displayed in TV program area 40. According to Schindler, a computer detects a user's television channel, and determines an ID code associated with the channel. The ID code is sent to a server 20 and the server 20 selects a chat room for the user corresponding to the ID code (See Fig. 2 and col. 6, ll. 26-43). The chat room is run by the server 20 and corresponds to TV programming (See, col. 4, ll. 53-65). Messages may be exchanged between participants in the chat room.

² It is acknowledged at page 3 of the Office Action that, "Schindler does not teach selecting a buddy list based on television programming."

more user-defined lists" and "displaying the selected initial buddy list to the network user on an instant messaging user interface."

Furthermore, the Office Action provides no suggestion or motivation to combine the teachings of Schindler, Porter, and Aravamudan. Therefore, a *prima facie* case of obviousness has not been established. Notably, Schindler, Porter, and Aravamudan are directed to different solutions for different problems. Schindler is directed to using the identity of a television channel as a basis for identifying and automatically linking to a computer chat room. Porter describes dynamic formation of a chat session facilitated by an information site or a third party chat server. Aravamudan is directed to assigning attributes to individual buddies within a buddy group to determine how each of those buddies perceive the user. Accordingly, there is no motivation to combine the teachings of Schindler, Porter, and Aravamudan.

For at least the foregoing reasons, independent claim 36, and its dependent claims 37-43 and 56-60, and independent claim 47, and its dependent claims 48-55 and 62-66, are patentable over Schindler in view of Porter and further in view of Aravamudan.

Claims 69-72 are dependent from independent claim 68, which as explained above, is patentable over Aravamudan. Porter and Schindler fail to remedy the deficiencies of Aravamudan for independent claim 68 or for dependent claims 69-72 for at least the reasons discussed above with respect to the selection and display limitations of independent claims 36 and 47. Accordingly, independent claim 68 and its dependent claims 69-72 are patentable over Schindler in view of Porter and further in view of Aravamudan.

35 U.S.C. § 103(a) Schindler/Porter/Aravamudan/DeSimone

Claims 44-46, 53-55, 61, 67, and 73 were rejected under 35 U.S.C. § 103(a) as being obvious over Schindler in view of Porter, further in view of Aravamudan, and further in view of DeSimone (U.S. Patent No. 6,212,548). Applicants respectfully request withdrawal of these rejections.

Claims 44-46, 53-55, 61, 67, and 73 depend from one of independent claims 36, 47, and 68 and are believed to be allowable for at least the reasons given above for claims 36, 47, and 68.

In particular, DeSimone does not remedy any of the deficiencies of Schindler, Porter, and Aravamudan that are noted above with respect to claims 36, 47, and 68. Moreover, DeSimone was not applied, and could not be applied, to remedy the deficiencies of claims 43 and 52, from which claims 44-46 and 53-55 depend. As such, it is respectfully submitted that Schindler, Porter, Aravamudan, and DeSimone, alone or in combination, do not establish a prima facie case of obviousness with regard to claims 44-46, 53-55, 61, 67, and 73.

35 U.S.C. § 103(a) Aravamudan/Schindler

Claim 74 was rejected under 35 U.S.C. § 103(a) as being obvious over Aravamudan in view of Schindler. Applicants respectfully request withdrawal of this rejection. Claim 74 depends from independent claim 68 and is believed to be allowable for at least the reasons given above for claim 68. In particular, Schindler does not remedy any of the deficiencies of Aravamudan that are noted above with respect to claim 68. Furthermore, the Office Action provides no suggestion or motivation to combine the teachings of Aravamudan and Schindler. Therefore, a prima facie case of obviousness has not been established. For at least these reasons, it is respectfully submitted that Aravamudan and Schindler, alone or in combination, do not establish a prima facie case of obviousness with regard to claim 74.

Conclusion

For at least the foregoing reasons, reconsideration and withdrawal of the rejections of claims 36-74 are respectfully requested.

Applicant : Carlos Silva et al.
Serial No. : 09/475,391
Filed : December 30, 1999
Page : 8 of 8

Attorney's Docket No.: 06975-048001 / AOLTV 07

Enclosed is a \$110.00 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 9/7/2004



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Attorney's Docket No.: 06975-048001 / AOLTV 07

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Carlos Silva et al.
Serial No. : 09/475,391
Filed : December 30, 1999
Title : TELEVISION CHAT ROOMS

Art Unit : 2141
Examiner : April Baugh

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

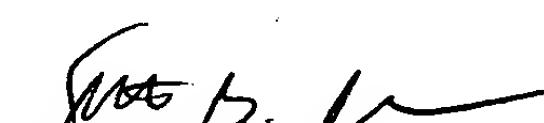
PETITION FOR ONE-MONTH EXTENSION OF TIME

Pursuant to 37 CFR §1.136, applicant hereby petitions that the period for response to the action dated May 7, 2004, be extended for one month to and including September 7, 2004.

Enclosed is a check for \$110 for the required fee. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 9/7/2004



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Attorney's Docket No.: 06975-048001 / AOLTV 07

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Carlos Silva et al.
Serial No. : 09/475,391
Filed : December 30, 1999
Title : TELEVISION CHAT ROOMS

Art Unit : 2141
Examiner : April Baugh

MAIL STOP AF
Commissioner for Patents
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Alexandria, VA 22313-1450

NOTICE OF APPEAL

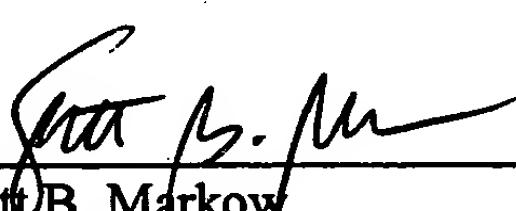
Applicant hereby appeals to the Board of Patent Appeals and Interferences from the action dated May 7, 2004, finally rejecting claims 36-74.

A petition for an extension of time under 37 CFR §1.136 to extend the time to respond to the final rejection for 1 month(s) to and including September 7, 2004 is enclosed.

A check in the amount of \$330 for the appeal fee is enclosed. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 9/7/2004



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Attorney's Docket No. 06975-048001		Mailing Date September 7, 2004	For PTO Use Only <i>Do Not Mark in This Area</i>
Application No. 09/475,391	Filing Date December 30, 1999	Attorney/Secretary Init WKR/STM/lbc	
Title of the Invention TELEVISION CHAT ROOMS			
Applicant Carlos Silva et al.			
Enclosures			
** Reply to Action of May 7, 2004 (8 pages) ** Petition for Extension of Time (1 month) (1 page) ** Check in the amount of \$110.00 for extension fee ** Notice of Appeal (1 page) ** Check in the amount of \$330.00 for appeal fee			
FR			

